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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,198	04/19/2001	Nobuyoshi Nakajima	2091-0239P-SP	1185
2292	7590	09/27/2005	EXAMINER HENDERSON, ADAM	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT 2615	PAPER NUMBER

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/837,198	Applicant(s) NAKAJIMA ET AL.	
	Examiner Adam L. Henderson	Art Unit 2615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 11, 12, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 is objected to because of the following informalities: On page 42, line 21, applicant states "composition\_data," this should be --composition data--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-4, 7-10, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US Patent 6,434,579) in view of Sarbadhikari et al. (US Patent 5,477,264).

With regard to claims 1-4; Shaffer et al. discloses a method of generating an album (FIG. 6) comprising an image (photocollage) in which a plurality of images, arranged in a desired layout (FIG. 4), from a digital camera (column 6 lines 41-43), and the images are stored in a recording medium (digital storage 50) with accompanying information (unique ID 49, column 6

lines 46-47). The album generation method includes reading the image data sets and accompanying information from the recording medium (column 6 lines 61-64) and generating composite data representing the composite image (column 6 lines 64-65) by inserting images in the insertions areas of a template (column 5 lines 28-61). Also disclosed is that additional information can be inserted into the template (column 5 lines 38-48, FIG. 5). Shaffer et al. does not disclose that the additional information is used in the creation of the composite image.

Sarbadhikari et al. discloses a digital still camera (FIG. 1) that places images into an overlay surround (FIG. 8). It is further disclosed that additional information, associated with the images stored in memory, can be used to enable the camera to automatically perform the image insertion into the templates (column 10, lines 28-39). In the case of the example in the text, the additional information is the name of the memory drive "Christmas Album." The camera uses this title information to associate the included images with the seasonal overlay templates, thus the additional information is used in this case to tie the image to the specific template and the insertion area within the template. It is further stated that in certain cases multiple images may be inserted into a single template (column 10 lines 63-64).

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the album generation method of Shaffer et al. to include the automatic image insertion process of Sarbadhikari et al. in order to allow the user to set a single format style and to then let the camera perform the rest of the processing with limited or no user intervention.

Claims 7-10 and 13-16 contain all the same limitations as claims 1-4 when it is understood that it would be obvious to create an apparatus that can perform a method and that an apparatus such as a camera or computer would inherently have some computer-readable

recording medium storing a program that would control the apparatus to perform the desired method. With this understanding, claims 7-10 and 13-16 are rejected for the same reasons as claim 1-4.

***Allowable Subject Matter***

5. Claims 5, 6, 11, 12, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Henderson whose telephone number is 571-272-8619. The examiner can normally be reached on Monday-Friday, 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on 571-272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALH

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September 22, 2005

  
DAVID L. OMETZ  
SUPERVISORY PATENT  
EXAMINER